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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,500	09/22/2000	Hatim Amro	16356.550 (DC-02468)	1986

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HAYNES AND BOONE, LLP  
901 MAIN STREET, SUITE 3100  
DALLAS, TX 75202

EXAMINER
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NGUYEN, QUANG N

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/668,500

Applicant(s)

AMRO ET AL.

Examiner

Quang N. Nguyen

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,7,8,10,11,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8,10,11,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Detailed Action***

1. This Office Action is in response to the Amendment filed on 08/09/2004. Claims 1-4, 7-8, 10-11 and 14-15 have been amended. Claims 5-6, 9, 12-13 and 16-22 have been cancelled. Claims 1-4, 7-8, 10-11 and 14-15 are presented for examination.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claims 1-4, 7-8, 10-11 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Himmel et al. (US 6,324,566), herein after referred as Himmel.**

4. As to claim 1, Himmel teaches a method comprising:

providing a first computer system including bookmarks (*the bookmark set is created and stored at the bookmark set server 305*) (Himmel, C6: L20-25);

providing a second computer system including a search engine (*any general purpose search facility such as www.yahoo.com hosting a search engine configured to receive search requests, i.e., search terms from the clients 307*) (Himmel, C6: 44-48);

providing a user computer system, each of the computer systems being interconnected via a communications network (*client browser 307, bookmark set server 305 and a general purpose search facility interconnected via the Internet*);

a user inputting a search term into the user computer system that specifies any websites associated with the bookmarks to be searched (*client 307 inputting one or more keywords, possibly a category of bookmark sets to be sent to the search engine*) (Himmel, C6: L50-52 and C8: L19-29);

the search engine receiving search term and accessing the bookmarks to obtain identifiers for the websites (*i.e., URLs*) associated with the bookmarks and providing search results to the user computer system; and the user displaying the search results (*in step 509, the search engine receives the search term, constructs and sends an SQL search query to the database of the bookmark set server; in step 511, a list of the bookmark sets which match the search criteria is compiled and sent to the client browser in an HTML page*) (Himmel, C8: L29-34).

5. As to claim 2, Himmel teaches the method of claim 1, further comprising:  
the search engine providing results of the searching to the user computer system  
*(a list of the bookmark sets which match the search criteria is compiled and sent to the client browser in an HTML page)* (Himmel, C8: L32-34).
6. As to claim 3, Himmel teaches the method of claim 1, further comprising: using a uniform resource locator (URL) to access the websites (Himmel, C5: L49-53).
7. As to claim 4, Himmel teaches the method of claim 3, further comprising: the search engine receiving the search term and an identifier that identifies the second computer system from the user computer system *(in step 509, the search engine receives the search term, and a "bookmark set" category identifying the database and/or the bookmark set server 305 containing the bookmarks)* (Himmel, C8: L29-32).
8. As to claim 7, Himmel teaches the method of claim 1, further comprising:  
accessing a file that includes bookmarks *(accessing the database/file containing bookmarks)* (Himmel, C8: L29-32); and  
creating the identifier in response to accessing the file *(creating a list of the bookmark sets containing URLs which match the search criteria)* (Himmel, C8: L32-34).
9. Claims 8, 10-11 and 14-15 are corresponding system claims of method claims 1-4 and 7; therefore, they are rejected under the same rationale.

10. Applicant's arguments as well as request for reconsideration filed on 08/09/2004 have been fully considered but they are moot in view of the new ground(s) of rejection.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER